

Atty Docket No.: R0130D-CON
USSN: 10/823,012

REMARKS

Claims 48, 52-54 and 56-58 are pending in the above-identified patent application. Claims 53 and 56-58 are amended herein. Claims 55 and 59-62 are canceled by this amendment. No new matter is introduced.

1. **Allowable Subject Matter**

The Applicants note with appreciation that claims 48, 52 and 54 are considered allowable.

2. **Claim Objections**

Claim 53 was subject to objection as being in improper multiple dependent form. Claim 53 has been amended to depend only from claim 48.

3. **Claim Rejections Under 35 USC §112 First Paragraph**

Claims 55-62 were rejected under 35 USC §112 first paragraph for failing to comply with the enablement requirement. The Examiner stated that the claimed subject matter was not described in the specification in such a way as to enable one skilled in the art to make and use the invention.

Claims 55 and 59-62 have been canceled. Claims 56-58 are amended herein to recite the treatment of urinary incontinence, and particularly stress incontinence and urge incontinence. As amended, claims 56-58 recite use of a single compound for treatment of a single indication.

The compounds of Applicants' invention are identified as being modulators of the alpha 1A or alpha 1L adrenoceptor (p. 30-31 of specification). Prior art demonstrates that modulators of the alpha 1 adrenoceptor can cause an increase in urethral closure pressure and are of use in the treatment of urinary incontinence (p. 1-2 of Applicants specification). Page 32 of Applicants' specification notes that alpha 1A/alpha 1L adrenoceptor activity of Applicants' compounds was determined using *in vitro* testing, and that *in vivo* testing was used to measure the effect of Applicants' compounds on intraurethral pressure. Examples 6 and 7 (p. 55-58) describe in detail the *in vitro* experimental measurement of alpha 1A/alpha 1L activity, and Example 8 (p. 58-59)

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describes the *in vivo* experimental measurement of intraurethral pressure in anesthetized rabbits upon administration of the compounds of the invention. The Declaration (37 CFR §1.132) of Counde O-Yang submitted on October 20, 2005 describes the effect on intraurethral pressure resulting from the claimed compound, as determined using the procedure of Example 8.

Applicants Accordingly believe that claims 55-58 as amended meet the criteria of 35 USC §112 first paragraph.

4. Claim Rejections Under 35 USC §112 Second Paragraph

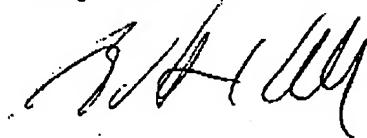
Claim 53 was rejected under 35 USC §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of Applicants' invention. The Examiner noted in particular the dependence from canceled claim 1 and the recitation of the variable "R¹³" which was not found in the formula. Applicants have amended claim 53 to correct its dependence to allowed base claim 48, and to delete the recitation of R¹³.

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CONCLUSION

In view of the foregoing, Applicants believe that the pending claims in the above identified patent application are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-354-7540.

Respectfully submitted,



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